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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,733	11/14/2001	Raymond V. Damadian	260/125	8924

7590 08/01/2006

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EXAMINER
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VARGAS, DIXOMARA

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/992,733	<b>Applicant(s)</b> DAMADIAN ET AL.	
	<b>Examiner</b> Dixomara Vargas	<b>Art Unit</b> 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28,30,31 and 65-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18,65,84,85,96 and 97 is/are allowed.
- 6) ☒ Claim(s) 19-28, 30, 31, 66-83, 86-95 and 98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 19-28, 31, 66, 67 and 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferut et al. (US 5,432,449 A).

With respect to claims 19 and 66, Ferut discloses a body portion (Figure 1 and 4, #50) having a longitudinal axis and first and second ends along the longitudinal axis (Figure 1, #51), at least one of the first and second ends (top and bottom of #50) being adapted to be mechanically connected to a magnetic resonance imaging system (Column 3, lines 67-68); a member having a first end connected to the body portion and a second end distanced from the body portion (mounting plate #54 in Figure 4 which receives bottom of #52); and a coil supported by the member (coil #64 supported by #54 and #52).

3. With respect to claim 20, Ferut discloses the coil is supported by the member proximate the second end of the member (Figure 4, #54 proximate to bottom of #52).

4. With respect to claims 21 and 67, Ferut discloses a container (Figure 4, #55) supported by the member, proximate the coil (Figure 5, #64); and a test substance with the container, the test substance being capable of emitting a magnetic resonance signal (Column 4, lines 34-36).

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5. With respect to claim 22, Ferut discloses the container is within a coil (Figure 4).
6. With respect to claim 23, Ferut discloses the test substance is chosen from the group consisting of petroleum jelly, water, salt water and nickel chloride (Column 4, lines 34-36).
7. With respect to claim 24, Ferut discloses the member is pivotally connected to the body portion (Figure 4, member #52 connected to #54).
8. With respect to claim 25, Ferut discloses a second coil wound around the body portion (Figure 4, multiple coil structures in arrangement #52).
9. With respect to claim 26, Ferut discloses the body portion comprises first and second members, the first member defining an opening for slidably receiving at least a portion of the second member (Figure 4, multiple coil structures in arrangement #52).
10. With respect to claim 27, Ferut discloses wherein the coil is wound around the first member (Figure 5).
11. With respect to claims 28, 89 and 98, Ferut discloses a test fixture for use in a MRI system comprising a longitudinal body portion having a longitudinal axis, the body portion (Figure 4, #54) comprising a first longitudinal member and a second longitudinal member (multiple members #52), defining an opening for slidably receiving at least a portion of the first member (opening #56), such that the first and second members may be moved with respect to each other to adjust the length of the body portion along the longitudinal axis of the body portion (each member #52 may be moved to be located in the top of each other on the top opening and therefore the length of each longitudinal member is adjusted); and a coil supported by the body portion (Figure 5, #64).

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12. With respect to claim 30, Ferut discloses a third longitudinal member connected to the body portion (multiple elements #52), and a second coil supported by the third longitudinal member (coils #64 inside each member #52).

13. With respect to claim 31, Ferut discloses a container (Figure 4, #55) by a third longitudinal member, within the second coil (each member #52 has a coil #64 with a container #55); and a test substance within the container, the test substance being capable of emitting a MR signal (Column 4, lines 34-47).

14. Claims 79 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobson (US 5,432,449 A).

With respect to claims 79 and 83, Jacobson discloses a test fixture for use in MRI system comprising (Figure 1): a base comprising a first and second telescoping members (members #55 and #57 with extensions #31, #33 and member #17 in structure #11); the base being extendable from a first length to a second length by extending at least one of the telescoping members with respect to each other (extending #31 from section #33 and also extending #33 from section #57 or extending #57 from section #55); a first coil directly supported by the first telescoping member (coils #13); a third longitudinal member pivotally connected to the second telescoping member (member #17 connected to base #11); and a second coil supported by the third member (coils #13); wherein the member is rotatable from a first position to a second position (#17 can be rotated through adjustment mount #21).

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15. Claims 68, 69 and 90-94 are rejected under 35 U.S.C. 102(e) as being anticipated by Hinks et al. (US 6,492,815 B2).

With respect to claim 68, Hinks discloses a test fixture comprising (Figure 1): a base having an axis (#27); a first coil coupled to the base in a first orientation with respect to the axis; and a second coil coupled to the base in the second orientation different from the first orientation, with respect to the axis (induction coils #24 and RF coil #26 located at orthogonal orientation from each other); wherein the fixture is adapted to be mechanically connected to an MRI system (Column 2, lines 15-58).

16. With respect to claim 69, Hinks discloses the first coil is wound around a second axis, the second axis being along a first direction; and the second coil is wound around a third axis, the third axis being along a different direction than the second axis (Figure 1).

17. With respect to claims 90-94, Hinks discloses a portion of the fixture (#100) is adapted to be mechanically connected to the MRI system (Column 2, lines 15-58; Figure 1).

***Allowable Subject Matter***

18. Claims 1-18, 65, 84-85 and 96-97 are allowed.

19. The following is an examiner's statement of reasons for allowance:

20. With respect to claims 1-15, 65, 85, 96-97, see applicant's remarks filed on 05/01/06.

a. With respect to claims 16-18 and 84 see previous action, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture for use in a magnetic resonance

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imaging system, comprising a longitudinally extending body portion comprising a third longitudinal member having a second longitudinal axis and being rotatable between a first position wherein the second longitudinal axis is parallel to the first longitudinal axis and a second position wherein the second longitudinal axis is perpendicular to the first longitudinal axis in combination with the remaining limitations of the claim..

b. With respect to claims 17, 18 and 84, the claims have been found allowable due to its dependency on claim 16 above.

21. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

22. Claims 70-78, 80-82, 86-88 and 95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. The following is a statement of reasons for the indication of allowable subject matter:

c. With respect to claim 70, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture comprising a member coupled to the base; wherein the second coil is coupled to the member in combination with the remaining limitations of claims 68 and 69.

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- d. With respect to claim 71-74, 78 and 86, the claim has been found allowable due to its dependency on claim 70 above.
- e. With respect to claim 75, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture comprising a base comprising a first and second telescoping members, and the first coil is supported in the one of the telescoping members in combination with the remaining limitations of claim 68 above
- f. With respect to claim 76, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture comprising telescoping member that comprises first and second longitudinal members; and the second longitudinal member defines a longitudinal opening for receiving the first longitudinal member such that at least one of the first and second longitudinal members may be moved with respect to the other to vary the length of the test fixture in combination with the remaining limitations of the claim 68 above.
- g. With respect to claim 77, the claim has been found allowable due to its dependency on claim 75 above.
- h. With respect to claim 80, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture for use in a MRI system comprising a first coil is wound around a first longitudinal axis along a first direction; the second coil is wound around a second longitudinal axis; and rotation of the member positions the second longitudinal



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axis of the second coil along a direction transverse to the first direction in combination with the remaining limitations of the claim 79 above.

i. With respect to claims 81-82, the claim has been found allowable due to its dependency on claim 80 above.

j. With respect to claim 87, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture for use in a MRI system comprising a first portion of the body portion is adapted to be mechanically connected to the MRI system; and a second portion of the body portion is adapted to be electrically connected to the MRI system in combination with the remaining limitations of the claim 28 above.

k. With respect to claim 88, the claim has been found allowable due to its dependency on claim 87 above.

l. With respect to claim 95, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a test fixture for use in a MRI system comprising a first portion of the body portion is adapted to be mechanically connected to the MRI system; and a second portion of the body portion is adapted to be electrically connected to the MRI system in combination with the remaining limitations of the claim 19 above.

### ***Response to Arguments***

24. Applicant's arguments filed 05/01/06 have been fully considered but they are not persuasive.

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25. Applicant argues that Ferut fails to disclose or fairly suggest longitudinal members with one end adapted to be connected to an MRI system.

26. The examiner disagrees with applicant's arguments because elements #52 as discussed in the rejection above are members and are considered longitudinal since they have a length through the longitudinal axis of the cylinder as seen on figure 4 and the fixture is adapted to be connected to the MRI system mechanically as seen on Figure 1 since the test fixture is capable of being positioned inside the bore. It has been held that the recitation that an element is "adapted to" perform a function is not positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

27. Applicant argues that Hinks fails to disclose or fairly suggest a fixture adapted to be connected to an MRI system.

28. The examiner disagrees with applicant's arguments because arrangement #100 as discussed in the rejection above is a fixture adapted to be connected to the MRI system mechanically as seen on Figure 1 and disclosed in the Abstract since the test fixture is capable of being positioned inside the bore. It has been held that the recitation that an element is "adapted to" perform a function is not positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

29. Applicant argues that Jacobson fails to disclose or fairly suggest one of the coils being directly supported by a telescoping member. The examiner disagrees with applicant's arguments because elements #31 and #33 are part of the telescoping member system and therefore is considered to be directly connected as seen on Figure 1.

***Conclusion***

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dixomara Vargas whose telephone number is (571) 272-2252. The examiner can normally be reached on Monday to Thursday from 8:00 am. to 4:30 pm..

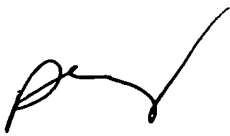
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dixomara Vargas  
Art Unit 2859  
July 24, 2006



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